

REMARKS

This amendment is submitted in response to the Official Action mailed May 18, 2005. In view of the above claim amendments and the following remarks, reconsideration by the Examiner and allowance of the application is respectfully requested.

Claims 1 and 16 have been amended to more particularly point out and distinctly claim the subject matter that applicant regards as the invention. Claim 1 has been amended to remove the requirement that the method be a computer-based method. As noted by the Examiner, this is supported by the disclosure of application number 08/585,173 filed April 16, 1996 and therefore does not introduce new matter. Claim 1 has also been amended to introduce the limitation of Claim 15 and require that the limiting step prohibit any amount of funds to be withdrawn as cash or spent on at least one class of goods or services. Claim 15 has been canceled and Claim 16 has been amended to depend from Claim 1 instead of Claim 15. These amendments do not introduce new matter.

Claims 8 and 9 have been amended to clarify that the periodic limit on the amount that can be spent on at least one class of goods and services and the limit on transactional amounts are additional limits that can be set by the fund depositor. Such limitations are needed for Claims 8 and 9 to further limit Claim 1 as amended and do not introduce new matter.

Instead, for reasons which are submitted below, the claims are believed to be in condition for allowance. The amendment to Claim 1 is believed to resolve the concerns raised by the Examiner. Accordingly, reconsideration is respectfully requested.

Turning to the Official Action, the Examiner did not consider priority application number 08/585,173 filed April 16, 1996 to support a computer-based method because the application did not mention a computer, and therefore extend Applicant's priority claim back to this application.

Applicant respectfully disagrees. The '173 application requires the use of banking infrastructure to support the claimed method, which implicitly employs computer-based methods. Furthermore, Claim 1 has been amended to remove the requirement that the method be computer-based. While this does not exclude computer-based methods, pursuant to *Ex Parte Lundgren* (Board of Patent Appeal and Interferences Appeal No. 2003-2088) computer-based methods need not be disclosed or claimed for an application to be directed to patentable subject matter. Accordingly, acknowledgement by the Examiner that the claims are entitled to the April 16, 1996 priority date of U.S. Patent Application Ser. No. 08/585,173 is respectfully requested.

Next, Claims 1 – 7, 10, 11, 13 and 14 were rejected under 35 U.S.C. §102(e) (2) as being anticipated by Fleming, U.S. Patent No. 5,953,710. The Examiner identified the features of the rejected claims disclosed by Fleming. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

As noted above, the claims enjoy the April 16, 1996 priority date of U.S. Patent App. Ser. No. 08/585,173 so that Fleming is no longer prior art against the present application. Furthermore, Claim 1 has been amended to add the limitation of Claim 15 directed to the limiting step prohibiting any amount of funds to be withdrawn as cash or spent on at least one class of goods or services. Claim 15 was not considered to be anticipated by or obvious in view of Fleming, so that by adding this limitation to Claim 1 the rejection of Claims 1 – 7, 10, 11, 13 and 14 under 35 U.S.C. §102(e) (2) as anticipated by Fleming has thus been overcome. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Next, Claims 8 and 9 were rejected as obvious under 35 U.S.C. §103(a) in view of Fleming, and further in view of Dethloff et al., U.S. Patent No. 4,837,422. Dethloff et al. was cited as disclosing limits on amounts spent on particular goods and services and limits on transactional amounts. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

To begin with, Fleming is no longer prior art against the present application. Furthermore, Claims 8 and 9 are directed to allowable subject matter by virtue of the features from former Claim 15 added to Claim 1. The Examiner did not reject Claim 15 in view of this cited prior art combination, so the addition of this limitation to Claim 1 renders Claims 8 and 9 patentable under 35 U.S.C. §103(a) in view of Fleming, and further in view of Dethloff et al. Reconsideration by the Examiner and withdrawal of this rejection is thus respectfully requested.

Next, Claim 12 was rejected as obvious under 35 U.S.C. §103(a) in view of Fleming, and further in view of Hilt et al., U.S. Patent No. 5,465,206. Hilt et al. was cited as disclosing supplying spending information by e-mail. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

As already noted, Fleming is no longer prior art against the present application. Thus, Claim 12 is also directed to allowable subject matter by virtue of the features from former Claim 15 added to Claim 1. The Examiner did not reject Claim 15 in view of this cited prior art combination, so the addition of this limitation to Claim 1 renders Claim 12 patentable under 35 U.S.C. §103(a) in view of Fleming, and further in view of Hilt et al. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Next Claims 15 and 16 were rejected as obvious under 35 U.S.C. §103(a) in view of Fleming, and further in view of Matsumoto et al., U.S. Patent No. 6,345,263. Matsumoto et al. was cited as disclosing preventing funds being withdrawn as cash or from being spent on a particular class of goods or services. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

Claim 15 has been canceled and the limitations of this claim have been added to Claim 1. This will be treated as a rejection of claims 1 and 16. In view of the April 16, 1996 priority date Fleming and Matsumoto et al. are no longer prior against the present application. Even if the

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Examiner were to disagree about this priority date, Matsumoto et al. was filed six days before the priority date the Examiner is willing to accept and under the Hilmer Doctrine Matsumoto et al. does not obtain the benefit of its Japanese priority date. If necessary, Applicant can prove a date of invention before the United States filing date of Matsumoto et al.

However, because the present application is entitled to claim priority to the application filed April 16, 1996 neither Fleming nor Matsumoto et al. are prior art against the present application. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Finally, Claim 17 was rejected as obvious under 35 U.S.C. §103(a) in view of Fleming, and further in view of Oncken et al., U.S. Patent No. 4,725,719. Oncken et al. was cited as disclosing preventing payment to an individual payee. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

As already noted, Fleming is no longer prior art against the present application. Thus, Claim 17 is also directed to allowable subject matter by virtue of the features from former Claim 15 added to Claim 1. The Examiner did not reject Claim 15 in view of this cited prior art combination, so the addition of this limitation to Claim 1 renders Claim 17 patentable under 35 U.S.C. §103(a) in view of Fleming, and further in view of Oncken et al. Reconsideration and withdrawal of this rejection by the Examiner is therefore respectfully requested.

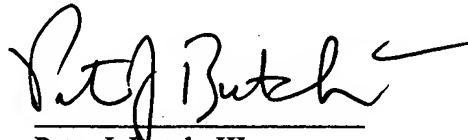
Accordingly, in view of the above claim amendments and the foregoing remarks, this application is now in condition for allowance. Reconsideration is respectfully requested. The Examiner is requested to telephone the undersigned if there are any remaining issues in this application to be resolved.

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Finally, if there are any additional charges in connection with this response, the Examiner is authorized to charge Applicant's deposit account number 19-5425 therefor.

Respectfully submitted,

11/18/05

A handwritten signature in black ink, appearing to read "Peter J. Butch, III", with a horizontal line underneath.

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